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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/810,392      | 03/19/2001  | Wang-Pin Pan         |                     | 5999             |

7590 04/22/2003

TROXELL LAW OFFICE  
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SUITE 1404  
FALLS CHURCH, VA 22041

EXAMINER

MICHENER, JENNIFER KOLB

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1762

DATE MAILED: 04/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/810,392

Applicant(s)

PAN, WANG-PIN

Examiner

Jennifer Kolb Michener

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Objections***

1. The original objections to claim 1 have been withdrawn based on Applicant's amendment.

### ***Examiner's Suggestions***

2. For clarity, Examiner suggests the following additional changes in the claim language of claim 1:

In line 1, the phrase "of the grip rubber" would be more clear and avoid antecedent basis problems if written -for grip rubber-.

### ***Claim Rejections - 35 USC § 112***

3. The original rejections of claim 1 under 35 U.S.C. 112, second paragraph, have been withdrawn based on Applicant's amendment.

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*The following new objections and rejections are made:*

***Specification***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. The specification is objected to for containing subject matter which is not described in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

On page 2, line 2, Applicant defines "PU resin" as "plutonium" resin. Examiner notes that plutonium is not a resin. Therefore, it is not clear how to make or use such a material. Examiner is not aware of plutonium in resin form. Second, it is not clear how one of ordinary skill would safely make or use plutonium on the rubber gripping part of exercise equipment.

***New Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one

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skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 requires the use of "PU resin" throughout. Upon review of the specification, page 2, line 2, Applicant defines "PU" as "plutonium". First, Examiner notes that plutonium is not a resin. Therefore, it is not clear how to make or use such a material. Examiner is not aware of plutonium in resin form. Second, it is not clear how one of ordinary skill would safely make or use plutonium on the rubber gripping part of exercise equipment.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In lines 3-5, the phrase "mixing mildewproof, antibacterial and aromatic agents in the resin-solvent mixture, wherein the mildewproof and the antibacterial agents is a chemical solvent" is unclear. The word "is" in the phrase "agents is a chemical solvent" is not grammatically correct so it is not clear if one or all of those agents are solvents. Additionally, Examiner wishes to be certain that Applicant intends both the mildewproof and the antibacterial agents to be solvents. If so, it is not clear that the chemical formula of claim 1 is a solvent. Further, it is not clear whether the aromatic agents listed must also be the same "chemical solvent" as the mildewproof and antibacterial agents.

There is no antecedent basis for the phrase "the water", which bridges lines 7 and 8. It is not clear whether the molded, coated grip rubber that is already fastened to an exercise device is to be dipped in a new solution of water or not.

In line 8, an alternative method appears to be presented in which it states "or the molded grip rubber" can be immersed into the solution of antibacterial agents, etc. However, the molded grip rubber had already been immersed in such a solution. Does Applicant intend this to be a second immersion step or does Applicant intend to say that the rubber is molded first and then immersed? If the latter is the case the term "the" molded grip rubber is confusing because it appears to be referring to the grip rubber that has already been coated.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Kolb Michener whose telephone number is 703-306-5462. The examiner can normally be reached on Monday through Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on 703-308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

A handwritten signature in cursive script, reading "Jl Kolb Michener".

Jennifer Kolb Michener  
Patent Examiner  
Technology Center 1700  
April 20, 2003